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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,893	01/17/2001	Shih-Chieh Hung	11709-003001	6011
26161	7590	12/16/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			GARVEY, TARA L	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,893

Applicant(s)

HUNG ET AL

Examiner

Tara L. Garvey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-7, 9-20, 23 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7, 9-11, 23 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 4-7, 9-20, 23 and 32 are pending. Claims 12-20 are withdrawn.

Claims 2, 3, 8, 21, 22 and 24-31 are canceled.

Response to Arguments

Claim Rejections - 35 USC § 112

The rejection of claim 32 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement for addition of new matter has been withdrawn in view of applicant's amendment of the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Applicant's arguments filed September 19, 2005 have been fully considered but they are not persuasive.

Claims 1, 4-7, 9-11, 23 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description and enablement requirements for reasons of record as set forth in the office action mailed on July 15, 2005.

The applicant argues that it is well known in the art that MSCs are plastic adherent cells that can be separated based on their adherence capacity. The applicant

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states that MSC can be purified by allowing the cells to adhere to a culture plate and removing the non-adherent cells. Specifically, MSCs will adhere to the plate and bone accessory cells do not adhere. In addition, the applicant argues that it is well known that MSCs are larger than PBLs and the average size of a bone precursor cell is between 8-70 microns. The applicant concludes that the cell size of MSCs and their ability to adhere to plastic are well known in the prior art. Therefore, the plate is limited to plastic or glass and the pore size has been amended to 0.4-20 microns.

In response to applicant's argument, the claims are drawn to method in which a cell mixture is applied to the cell culture device. The cell mixture can comprise any type of cell, particularly since the specification discloses that the cell mixture can be obtained from fractioned tissue, unfractioned tissue and a body fluid. Many types of cells, other than MSC, have the ability to adhere to a tissue culture plate and are large in size that they will not pass through the pores. Therefore, it is unlikely that the cell culture device described will only allow MSCs to adhere to the plate and allow all cells but MSC to pass through the pores.

Claims 1, 4-7, 9-11, 23 and 32 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description and enablement requirements for the same reason as set forth in the previous office action and above.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

Claims 1, 4-7, 9-11, 23 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This a rejection for new matter.**

In a method of recovering mesenchymal stem cells from a mixture of cells, the specification describes a culture device that comprises a plate with pores where the "pore size ranges from about 0.4 to 40 microns" on page 7, lines 28-29.

The specification does not describe a cell culture device for recovering mesenchymal stem cells from a mixture of cells in which the pore size ranges from 0.4 to 20 microns. Thus, the newly added limitation to claim 1 constitutes new matter.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara L Garvey whose telephone number is (571) 272-2917. The examiner can normally be reached on Monday through Friday 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) (<http://pair-direct.uspto.gov>) can now contact the USPTO's Patent Electronic Business Center

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(Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Tara L Garvey
Examiner
Art Unit 1636

TLG

CELIAN QIAN
PATENT EXAMINER

